



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MF

7C

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/907,635	08/08/97	ENOKIDA	M 35.C10457CON
------------	----------	---------	----------------

WM01/0410
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3801

EXAMINER

HONG, S

ART UNIT	PAPER NUMBER
----------	--------------

2176

43

DATE MAILED: 04/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/907,635

Applicant(s)
Enokida et al.

Examiner
Stephen Hong

Group Art Unit
2176



☒ Responsive to communication(s) filed on Jan 22, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 62-86 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 62-86 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. This action is responsive to communications: CPA and preliminary amendment filed 1/22/01 to the application filed 8/8/97, which is a FWC of the application Ser. No. 09/378,819, filed 1/27/95.
2. Claims 62-86 are pending in this case. Claims 62, 76, 77, and 86 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371² of this title before the invention thereof by the applicant for patent.

5. Claims 62-72, 76-82 and 86 are rejected under 35 U.S.C. 102(e) as being anticipated by Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claim 62, Bonomi discloses the following claimed elements of a moving image editing apparatus:

- input means and decoding means for decoding encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image (col.2, line 54, "The video compression circuit ...compress the video data ...using both interframe and intraframe algorithm ...[and the] video decompression circuit decompresses intraframe-only compressed video data to allow editing");

- encoding means for intraframe coding the decoded moving image data and storing the intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2, line 57, "intraframe-only compressed video data ...allow video editing to occur in the host processor."); and

- second encoding means for encoding the edited image data by an encoded method that includes encoding in which the interframe correlation is considered (col.2, line 59, "When the video editing is complete, the videothe video compression circuit to compress the video data using both intraframe and interframe algorithm.").

As per dependent claims 63-64, Bonomi teaches designating a picture for editing (col.3, lines 1-10)

As per dependent claims 65-69, Bonomi teaches encoding the images in MPEG, which contains the predetermined number of intra-coded pictures (see col.1, lines 25 +, "the standard is the MPEG...") and JPEG (col.1, lines 40-45)

As per dependent claim 72, Bonomi discloses **an edition in a time base direction between frames** (col.1, line 52, "Typical editing activities include special effects, titling, mixing, fades and wipes...").

As per dependent claim 70 and 71, Bonomi discloses **displaying the decoded image data** (col.3, line 52, "...decompressed the video data to display the video images on display").

Claims 76-82 and 86 recite substantially similar limitations as claims 62-72, and are similarly rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 73-75 and 83-85 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Nguyen, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claims 73-75, Bonomi teaches the editing features of insertion and deletion of number of pictures. However, Nguyen discloses **animation images displayed in multi-screen displays that are obtained by reducing the frame images** (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames, and Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ..."). Nevertheless, Bonomi teaches the editing activities including "mixing, fades and wipes" (col.1, line 52), which require manipulating the number of pictures. Therefore, the features would have been obvious to a person of ordinary skill in the art at the time the invention was made in view of Bonomi's suggestions.

Claims 83-85 recite substantially similar limitations as claims 73-75, and are similarly rejected under the same rationale.

Response to Amendment

8. Applicant's arguments filed 1/22/01 have been fully considered but they are not persuasive.

No specific arguments has been presented with respect to the newly presented claims.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,
Sixth Floor (Receptionist).


Stephen Hong

Primary Examiner

April 9, 2001